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T.B.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/450,649 11/30/99 KATO

A 0020-4633P

EXAMINER
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QM12/0522

BIRCH STEWART KOLASCH & BIRCH LLP  
P O BOX 747  
FALLS CHURCH VA 22040-0747

GORDON, R	
ART UNIT	PAPER NUMBER

3711  
DATE MAILED:

05/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/450,649

Applicant(s)

Akira Kato

Examiner

Raeann Gorden

Art Unit

3711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Mar 12, 2001

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-4 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-4 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yabuki.

Yabuki et al discloses a golf ball comprising a solid center composed of an inner center formed from a vulcanized molded rubber composition containing an oily substance and a center outer layer formed from an oil-resistant substance to prevent the oily substance from bleeding. A thread rubber layer is adjacent to the solid center and a cover is formed over the thread rubber layer (abstract). The inner center has a diameter between 24 and 33 mm and the solid center has a diameter between 25 and 34 mm (col 4, line 33, col 3, line 47). The outer center layer is made from a thermoplastic resin as the main ingredient (col 3, lines 30-40). The thermoplastic resins claimed by applicant are commonly known in the art and are suitable for the purpose. See In re Leshin, 125 USPQ 416. The cover has a Shore D hardness from 40 to 60 (col 7, line 49) and thickness of 1 to 3 mm. The center has a deformation between 1 and 5 mm (col 4, lines 25-30). The hardness values of the core layers are obvious features of the prior art since the material content is identical to Applicant's. One of ordinary skill in the art would have included

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additional types of thermoplastic resins for the outer core layer to obtain optimal performance characteristics.

***Response to Arguments***

3. Applicant's arguments filed 3-12-01 have been fully considered but they are not persuasive. Applicant argues the Yabuki reference discloses a thermoplastic resin (ionomer resin) as an oil resistant layer and does not disclose any other resins. Since Yobuki discloses that any oil-resistant substance having flexibility such as thermoplastic resins or oil-resistant rubbers can be used it is clear that the present invention is included. Applicant claims a polyurethane thermoplastic elastomer, polyester thermoplastic elastomer, polyamide thermoplastic elastomer or mixtures thereof, all of which are categorized as thermoplastic resins. Applicant further argues that using an ionomer or NBR(N230S) for the outer core layer as shown in the Examples of Yabuki and Applicant's comparative examples 2-3 result in a golf ball with poor rebound characteristics and shot feel. Yobuki discloses examples with NBR (oil resistant rubber) but does not show examples with thermoplastic resins. However, Yabuki reveals in the disclosure that either a thermoplastic resin or oil-resistant rubber may be used for the outer core layer. Applicant invention is clearly encompassed by the Yabuki reference. Furthermore, thermoplastic resin, such as the resins claimed by applicant, are commonly known in the art and are suitable for the purpose. See *In re Leshin*, 125 USPQ 416.

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*Conclusion*

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is (703) 308-8354. The examiner can normally be reached Monday-Thursday and alternating Fridays from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeanette Chapman, can be reached on 703-308-1310. The fax number for the organization where this application or proceeding is assigned is 703-308-7768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

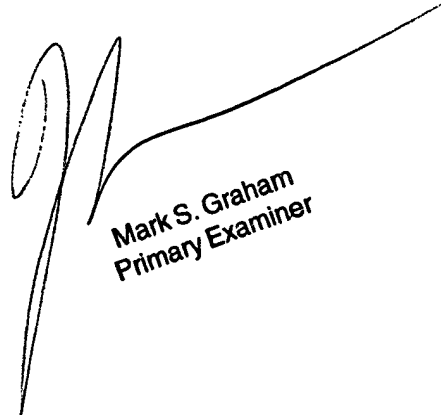
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May 17, 2001



Mark S. Graham  
Primary Examiner